Remarks

Reconsideration of this application is respectfully requested.

In the Office Action dated June 27, 2006, the Examiner objected to certain inadvertent typographical errors that appeared in the specification. Applicants have corrected the errors. No new matter has been added. Withdrawal of the objection is requested.

The Action rejected claims 19 – 39 under 35 U.S.C. § 101 for directing claims towards non-statutory subject matter. Specifically, the Action stated that claims 19, 30, and 35, failed to include a tangible result in connection with the claim language "producing a citation list."

Applicants have amended claims 19, 30, and 35 to claim "producing a citation list in an electronically accessible medium." Withdrawal of the rejection is requested.

The Action rejected claims 19 – 21, 27, 28, 30 and 35, under 35 U.S.C. § 102(b), as being anticipated by U.S. Patent No. 5,991,751, issued to Rivette et al. (Rivette). The Action additionally rejected claims 22, 29, 31, 34, 36, and 39, under 35 U.S.C. § 103(a), as being unpatentable over Rivette in view of Tanner et al., U.S. Published Patent Application 2004/0243588 (Tanner). Finally, the Action rejected claims 23 – 26, 32, 33, 37, and 38, under 35 U.S.C. § 103(a), as being unpatentable over Rivette in view of non-patent literature reference Dialog.

In order to advance prosecution, Applicants have cancelled claims 20, 23, 24, 32 and 37, and amended independent claims 19, 29, 30, 34, 35, and 39. Applicants' amendments to the independent claims incorporate subject matter previously contained in the cancelled claims.

Specifically, Applicants have amended the independent claims to include the feature of "including a name of an entity" in the search queries as claimed, and "automatically using at least one additional name for searching, wherein said additional name is obtained from an entity names table and wherein said identifies said additional name as representative of said same entity." The prior art of record neither discloses nor suggests these features.

The Action admits at page 16 that Rivette does not disclose the use of citation search query containing the name of an entity further comprising the use of an additional name associated with the entity. The Action alleges that Dialog supplies the missing teaching. Specifically, the Action alleges that Dialog, at pages 2-2 to 2-8, discloses using an additional name for searching where the additional name is associated with the name of the entity. The Action is incorrect in that allegation, and furthermore, Dialog also fails to disclose that the additional name is obtained from an entity names table, as is claimed by Applicants.

The selection in Dialog referenced by the Action is directed towards searching a patent database using an EXPAND search command, and combining it with the Derwent World Patents Index assignee code. As can been seen at page 2-3, the exemplary search is for a fictitious company Genetech. By using the EXPAND command, the user receives additional names in alphabetic proximity to the desired entity search term, of which, none are required to be associated with the same entity. Then the user must manually individually select whether any of these alphabetically proximate names should be included in the subsequent search query as being

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associated with the desired entity. In Dialog, there is nothing automatic in the selection of which names in the expanded list are to be included in the query.

Moreover, there is no indication in Dialog that the selection of a particular name from the list will be a name which is in fact actually associated with the same entity to be searched. For example, at page 2-4, the fictitious search for Genetech is equated to a four-letter code GETH which is supposed to be associated to the entity Genetech. However, as can been seen in this example, the user must still perform an EXPAND command to examine the results from the query, and even then the GETH command fails to produce only names associated with Genetech. Of results E1 through E12, several have no association to the entity to be searched. It is a coincidence if any alphabetically proximate name represents the same entity.

The Dialog disclosure itself admits the unreliability of associating any one of its search query methods individually, i.e., either by EXPAND of entity name or EXPAND of entity code. In the middle text box at page 2-4, Dialog states, "Using both the name and the code is the most comprehensive way to search by patent assignee. In this example [where both methods were not used] we did not pick up additional patents." Further, in the bottom text box at page 2-4, Dialog states, "Never rely on one method or another if a unique code is provided by the database." Thus, the name search of Dialog is conducted by analyzing a desired entity term entered by a user, expanding the entity term to identify names within alphabetical proximity to the entity, having a user identify whether any of the expanded search names happen to be associated with the entity, and then repeating the entire set of steps using a code supplied from the Derwent World Patents Index. Finally, Dialog states at page 2-2, that this entire search method of name

and code EXPAND searching only will work with entities having at least fifty (50) or more patents.

Applicants amended claims include a citation search system which, among other things, claims "including a name of an entity" and "automatically using at least one additional name for searching, wherein said additional name is obtained from an entity names table, and wherein said table identifies said additional name as representative of said same entity." This is distinct from the method disclosed in Dialog. Applicant's method as claimed <u>automatically</u> utilizes an entity names table which identifies additional names representative of the entity to be included, whereas Dialog discloses a method in which random names alphabetically proximate to the entity are produced, and a user must <u>manually</u> determine whether any of the displayed names should be included and manually select those names.

In order to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2142. The Action has not satisfied these requirements, and therefore has failed to establish a prima facie case of obviousness.

Because the Action admits that Rivette fails to teach the use of an entity names table for automatically obtaining an additional name, where the additional name is representative of the entity, and because Dialog fails to supply this missing teaching, withdrawal of the rejection to

independent claims 19, 29, 30, 34, 35, and 39 is requested. All remaining claims are dependent

upon these independent claims and should be allowable at least the same reason as the

independent claims.

The Action additionally rejected claim 21, under 35 U.S.C. § 102(b) as being anticipated

by Rivette. Specifically, the Action alleged that Rivette disclosed a citation search method

further comprising translating information used for producing a citation list. Applicants have

amended claim 21 to recite that the computer-based citation search method further comprises,

"translating said search query comprising at least one patent identification condition and

including a name of an entity from a first <u>content</u> language to a second <u>content</u> language."

Support for the amendment can be found throughout the specification and the drawings, and

particularly at paragraphs [0027] and [0036], and Figures 3 and 5.

Referring to Rivette, columns 29 and 30, the use of the terms "language," "translate,"

"foreign," "native" and derivatives thereof are clearly to be interpreted in the context of

computer software interaction, i.e., transforming a computer-based search command from the

database computer language of one system into another computer language that is used or is

recognized by the database to be searched. Rivette, at column 29, line 61-64 refers to the "native

language" command line GUI (Graphic User Interface), as an enterprise server API (Application

Programming Interface). API is defined at www.thefreedictionary.com as "a set of definitions of

the ways <u>one piece of computer software communicates with another</u>. It is a method of achieving

abstraction, usually (but not necessarily) between lower-level and higher-level software." At

column 30, lines 6 – 11, Rivette states, "The invention provides foreign language command line

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GUIs to support those users who are familiar with database query languages other than the

enterprise server API [the "native language"]. Such database query languages are herein called

foreign query languages for reference purpose." Thus, Rivette's use of the words and phrases

above are consistent with explaining the interactions of different computer software in different

databases; specifically enterprise server API software(the "native language") and non-enterprise

server API (the "foreign language"). Finally, Rivette's use of the term "translate" and

derivatives thereof at column 30, lines 21 – 26 describes the method by which the "foreign

language" search query is translated by a translator in the enterprise server API to the "native

language" prior to performing the search.

Applicants' use of the terms "translate" and "language," and derivatives thereof are

directed towards the content of the patent documents contained within the patent database. Thus

translating the language of the search query, as claimed by Applicants refers to the language of

the content in the fields to be searched in the patent database. "Content" as used by Applicants'

is clearly understood by one skilled in the art to be directed towards the text of the patent

documents themselves, and not the computer software instruction language that executes the

search.

Rivette fails to teach each and every element of Applicants' invention as claimed in claim

21 and thus the Action has failed to show that Rivette anticipates Applicants' claim under §

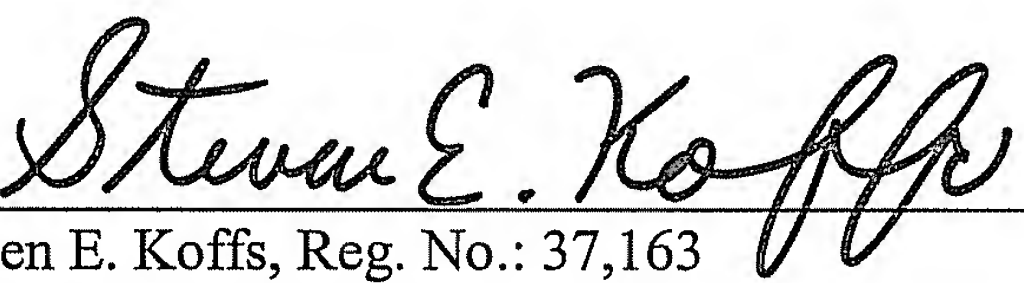102(b). Withdrawal of the rejection is requested.

In view of the foregoing amendments and remarks, Applicant submits that this application is in condition for allowance. Early notification to that effect is respectfully requested.

The Assistant Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account **04-1679.**

Respectfully submitted,

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